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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,771	11/04/2003	Marlene C. Schwarz	12013/53907	5897
23838	7590	04/07/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			LAMB, BRENDA A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,771

Applicant(s)

SCHWARZ ET AL.

Examiner

Brenda A. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 26, 28, 29, 32-35, 40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 26, 28, 29, 32-35, 40 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2006 has been entered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 and 42-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach or suggest the combination of a cage positioned in a coating chamber and a vibration source wherein the vibration source generates pressure waves sufficient to suspend the cage above the vibration source without the vibration source contacting the cage.

The originally filed specification fails to teach or suggest the cage is a stent.

The originally filed specification fails to teach or suggest the cage is a vena-cava filter.

The originally filed specification fails to teach or suggest the vibration source may move independently from the coating chamber.

The originally filed specification fails to teach or suggest the screen may move independently from the vibration source.

If applicant disagrees then he needs to provide support in the specification and/or drawings.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3, 4-5, 40 and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is confusing since it is unclear how the supply of coating is related to the source of coating set forth in claim 4. The recitation in the preamble of claim 4 that the system coats a medical device yet it is unclear what is coating the medical device since the body is silent as to how the medical device is coated. Claim 40 is confusing since it is unclear what the means for supplying encompasses that it is unclear whether the recited means includes the combination of the source of therapeutic coating and nozzle or the nozzle itself or source of coating itself.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blomstrom in view of Leidner et al and Tso et al.

Blomstrom teaches a method and apparatus for spraying substrates arranged on a conveyor belt which oscillates or vibrates, thereby reading on a movable conveyor belt and the conveyor conveys the substrates such that they pass under a series of spray nozzles. Blomstrom teaches the spray nozzles spray canthaxanthin onto the substrate and canthaxanthin is a known antioxidant as taught by Tso et al column 10 at lines 11-13 and antioxidant are a type of therapeutic material as taught by Leidner et al (see Leider et al at column 8 line 64 to column 9 line 6). Blomstrom apparatus is capable of

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coating a medical implant since it teaches every claimed element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Blomstrom therapeutic coating is capable of covering at least a portion of an outside surface of the medical implant after the medical implant is removed from the coating area if one desires to remove the coated substrate from the coated area immediately after coating and dry the coated substrate in a separate area from the coating area such as a drying area.

Claim 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blomstrom in view of Leidner et al, Tso et al and Korstvedt.

Blomstrom, Leidner et al and Tso et al are applied for the reasons noted above. Blomstrom fails to teach the coating area is a confined space with an entrance and an exit and the conveyor belt urges the substrate from the entrance to the exit of the coating area. However, it would have been obvious that to use as the vibrating conveyor assembly in the Blomstrom process one that includes a traveling vibrating conveyor belt with guide rails thereby providing a confined space above the conveyor belt such as taught by Korstvedt for obvious reason to prevent the coated substrate from falling off the lateral edges of the moving conveyor belt and move the coated substrate on the traveling conveyor belt from the entrance to the exit of the confined space for the

obvious reason to enable the substrates to be treated in the additional process steps downstream from the coating process step.

Claims 3-6, 8, 32-35 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Alkan et al.

Alkan et al teaches the design of an apparatus for coating a medical implant as shown in Figure 1. Alkan et al apparatus is comprised of the following elements: a coating chamber or cavity which is defined by funnel 1; a vibration source, the vibration source adapted to suspend a medical device in the coating chamber; and a coating source, the coating source positioned to introduce coating into the coating chamber wherein the coating source includes a nozzle 13 coupled to a supply of coating and wherein the vibration source is positioned below and not directly coupled to a screen 3 which is arranged in the lower portion of the coating chamber defined by funnel 1, and wherein the vibration source is adapted to generate pressure waves of compressible fluid containing enough energy to lift a medical device positioned in the coating chamber away from the screen 3. Thus element of the claimed apparatus as set forth in claim 6 is taught by Alkan et al. With respect to claim 4, the examiner has interpreted that the cage is the medical device being coated especially in view of dependent claim 3 which claims the cage is a stent which is a medical device. Alkan et al teaches a system for coating a substrate comprising the following elements: a coating chamber defined by the funnel 1; a vibration source, the vibration source configured to generate pressure waves sufficient to suspend the substrate positioned in the coating chamber above the vibration source without the vibration source contacting the substrate which is

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positioned above screen 3 which is arranged in the lower portion of the coating chamber; and a coating source, the coating source positioned to introduce coating into the coating chamber. Alkan et al is capable of coating a medical device which is a cage since it teaches every claimed element of the claimed apparatus/system. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 3, Alkan et al is capable of coating a cage which is a stent since it teaches every claimed element of the claimed apparatus/system. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 42, Alkan et al vibration source is exposed via apertures in screen 3 to the coating chamber. With respect to claim 43, Alkan et al is capable of coating a cage which is a vena-cava filter since it teaches every claimed element of the claimed apparatus/system. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claims 5 and 44-45, Alkan et al coating source is positioned above the screen in the coating chamber as shown in Figure 1 and the vibration source is positioned below the screen 3. Alkan et al coating source or supply of coating contains materials which can be therapeutic (see Example 2). Alkan et al coating from a coating source is capable of covering the surface of the medical device after the medical device is removed from the coating chamber. With respect to claim 26, Alkan et al an apparatus for coating a medical implant comprising: a coating area sized to accept medical implants for implantation within the body of a patient; coating source or supply of coating contains materials which can be therapeutic (see Example 2) thereby reading on a source of therapeutic coating having an exit point in fluid communication with the coating area; a screen positioned in the bottom portion of the coating area; and a vibration source positioned beneath the screen, the vibration source adapted to vibrate at a rate sufficient to lift a medical implant positioned on the screen away from the screen. The recitation that the screen may move independently from the vibration source does not further limit the apparatus over Alkan et al since the screen is directly supported by the walls of the funnel 1, not the vibration source, and therefore the screen may be moved separately or independently from the vibration source by for example replacing the screen which was inserted into the funnel by dissolving the glue holding the screen in the funnel. With respect to claim 32, Alkan et al vibration source is

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exposed via apertures in screen 3 to the coating chamber. With respect to claim 33, Alkan et al shows the exit point comprises a nozzle 13. With respect to claim 34, Alkan et al shows in Figure 1 that the coating area is an enclosed area that is enclosed on three sides and is defined by the wall of funnel 1 and the screen 3. With respect to claim 35, Alkan et al coating source or supply of coating contains materials which can be therapeutic. Alkan et al therapeutic coating is capable of covering at least a portion of an outside surface of the medical implant after the medical implant is removed from the coating area if one desires to remove the coated substrate from the coated area immediately after coating and dry the coated substrate in a separate area from the coating area such as a drying area. With respect to claim 8, the same rejection applied to claims 4-5 and 42 is applied here. Alkan et al teaches at column 3 lines 18-25 a controller to control the acoustic diaphragm so as to vibrate the diaphragm at the desired frequency such that the medical device is capable of being suspended in the coating chamber. Alkan et al apparatus inherently includes a power source to provide the motive force for the loud speaker to work. The recitation that the vibration source may move independently from the coating chamber is so broad that it reads on the vibration source being independently movable from or independently separable from the coating chamber by movement away from the coating chamber by disassembly. Example 1 teaches that the walls of the funnel 1 which define the coating chamber closely fit and overlap over the wall of supporting tube 4 which is part of the vibration source and, therefore, the Alkan et al coating chamber may be disassembled from the vibration source by obviously pulling apart the above cited elements thereby reading on

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the claimed limitation of the vibration source being movable independent from the coating chamber.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al in view of Holt.

Alkan et al is applied for the reasons noted above. Alkan et al fails to teach a coating filter coupled to the coating chamber. However, it would have been obvious to modify the Alkan et al apparatus by providing a coating filter which is operatively coupled to the coating chamber through the coating nozzle such as taught by Holt for the obvious reason to prevent plugging of the coating nozzle.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al in view of Wurster 3,253,944.

Alkan et al is applied for the reasons noted above. Alkan et al fails to teach the nozzle is positioned beneath the vibration source. However, it would have been obvious to modify the Alkan et al by arranging the coating nozzle beneath a portion of the Alkan et al vibration source which includes tube 4 as well as beneath the screen 3 since Wurster shows doing so for the taught advantage of coating the tablets as they travel upwardly and out of contact with each other.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wurster 3,253,944 in view of Alkan et al and Zingerman et al 3,431,138.

Wurster teaches an apparatus for coating a substrate comprising: a coating area; means for supplying a coating into the coating areas which the examiner has interpreted as the source of coating for supplying coating into the coating area; and means for

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suspending the substrates in the coating area includes the coating nozzle. Wurster fails to teach the means for suspending the substrate in the coating area also includes a vibration structure. However, it would have been obvious to modify the Wurster apparatus by connecting its gas supply inlet means 26 to a vibration structure such as shown by Alkan et al (elements 4 and 6-9) for the taught advantage of greater control of the movement of the particles in the coating area. Further, it would have been obvious given the modifications of the Wurster apparatus to provide as the source of coating one that is therapeutic since it is known in the art as exemplified by Zingerman to coat tablets with materials which can obviously can provide a therapeutic benefit. Wurster apparatus as modified is capable of coating a substrate which is a medical implant since it teaches Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Claim 5, 8, 26 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al in view of Wurster 3,253,944.

Alkan et al is applied for the reasons noted above. The same rejection applied to claims 5,8, 25 and 32-35 is applied here. Alkan et al teaches a source of coating material and components of the source of coating material may be therapeutic. In any event, it would have been obvious to provide as the source of coating material in the

Alkan et al apparatus/system one that is therapeutic since it is known in the art as exemplified by Zingerman to coat tablets with materials which can obviously can provide a therapeutic benefit.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday with alternate Wednesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A. Lamb
BRENDA A. LAMB
PRIMARY EXAMINER